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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,349	03/15/2001	John Tree	SOA-336	3465
23353	7590	05/16/2005	EXAMINER	
RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036			KING, JUSTIN	
			ART UNIT	PAPER NUMBER
			2111	

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/808,349

Applicant(s)

TREE ET AL.

Examiner

Justin I. King

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-30, 32-35, and 37-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-30, 32-35, and 37-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the integrated electrical jack providing output to a speaker as claimed in claim 27, a modem output as claimed in claim 28, and wireless communication as claimed in claim 32 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered; any new drawing must be supported by the Specification originally presented.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 15-30 and 33-35 and 37-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15 and 33 recite, “the shape of said case when *accepting* said electronic device being different than said shape of said case when *enclosing* said electronic device”. The “accepting” and “enclosing” are not clearly distinguishable. Examiner suggests using “said case with said electronic device enclosed” and “said case without said electronic device enclosed”.

Claims 16-29, 24-25, and 37-39 are rejected because they incorporate parent claims’ limitations.

4. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 32 depends on a canceled claim.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 15-19, 21, 23, 33-35, and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yamamoto et al. (U.S. Patent No. 4,006,764) and Matsumoto (U.S. Patent No. 5,325,139).

Referring to claims 15 and 33: Yamamoto discloses a protective material (figure 7, structure 5) for accepting an electronic device (figure 7, structure 1), and the electronic device (the tape recorder and radio) has user controls and control circuitry. Since Yamamoto's protective material is vinyl chloride (abstract), Yamamoto's protective material's shape differs between an empty protective material and a protective material containing the electronic device within. Yamamoto's protective material does not explicitly include a controlling interface.

Matsumoto discloses an underwater camera case with exterior user controls (figure 1, structures 29 and 24) disposed on the protective material. Matsumoto teaches that the protective material protect the device from the environment which may damage the device, and Matsumoto teaches exterior user controls on the protective material to enhance the user's ability to continue operating the enclosed device without removing the protective material. Hence, it would have been obvious to one having ordinary skill in the art at the time Applicant made the invention to adapt Matsumoto's teaching onto Yamamoto because Matsumoto teaches one how to continue

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operating the enclosed device without removing the protective material and losing the protection from the protective material.

Referring to claims 16, 34, and 41: Yamamoto's enclosed radio is operable separate and apart from the case.

Referring to claims 17 and 35: Yamamoto discloses an audio device (radio).

Referring to claim 18: Yamamoto discloses dented groove and protruding range (figure 10, structures 24a-b) to fasten the protective material; Yamamoto's dented groove and protruding range are equivalent to the claimed snap device.

Referring to claim 19: Both Yamamoto (column 4, lines 18-19) and Matsumoto's protective material is waterproof.

Referring to claim 21: Yamamoto's protective case has a packet porting to accept the electronic device (figure 10).

Referring to claim 23: Yamanoto discloses the speaker (figure 7, structure 2).

Referring to claim 40: Yamamoto discloses a protective material (figure 7, structure 5) for accepting an electronic device (figure 7, structure 1), and the electronic device (the tape recorder and radio) has user controls and control circuitry. Since Yamamoto's protective material is vinyl chloride (abstract), Yamamoto's protective material's shape differs between an empty protective case and a protective case containing the electronic device within. Yamamoto discloses dented groove and protruding range (figure 10, structures 24a-b) to fasten the protective material; Yamamoto's dented groove and protruding range are equivalent to the claimed snap device. Yamamoto's protective material does not explicitly disclose a controlling interface.

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Matsumoto discloses an underwater camera case with exterior user controls (figure 1, structures 29 and 24) disposed on the protective material. Matsumoto teaches that the protective material protect the device from the environment which may damage the device, and Matsumoto teaches exterior user controls on the protective material to enhance the user's ability to continue operating the enclosed device without removing the protective material. Hence, it would have been obvious to one having ordinary skill in the art at the time Applicant made the invention to adapt Matsumoto's teaching onto Yamamoto because Matsumoto teaches one how to continue operating the enclosed device without removing the protective material and losing the protection from the protective material.

8. Claims 20, 22, 24-27, and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yamamoto, Matsumoto, and Narayanaswami (U.S. Patent No. 6,657,654).

Referring to claims 20, 37, and 39: Yamamoto and Matsumoto's disclosures are stated above; neither one explicitly discloses that the exterior user controls produce command signals operating functions that are not operated by the user controls and control circuitry.

Narayanaswami discloses an electronic attachment/case including a camera function.

Narayanaswami teaches one to add additional functions to an existing electronic device.

Narayanaswami provides that user does not need to purchase individual devices (modem, scan, and videophone, and camera, column 2, lines 8-11) for desired functions. Narayanaswami teaches one to expand the existing device's resource to obtain additional functions and to reduce the bulk user needs to carry (column 2, lines 10-11). Hence, it would have been obvious to one

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having ordinary skill at the time Applicant made the invention to adapt Narayanaswami's teaching onto Yamamoto and Matsumoto because Narayanaswami teaches one to expand the existing device's resource to obtain additional functions and to reduce the bulk user needs to carry.

Referring to claim 22: Narayanaswaim discloses the connection port (figure 2, structure 140).

Referring to claims 24 and 38: Narayanaswaim's controlling interface is an upgraded set of controls.

Referring to claim 25: Since Narayanaswaim's camera attachment case provides a new function, the controlling interface produces command signals that operate function that are not operated by the enclosed electronic device.

Referring to claims 26-27: Narayanaswaim discloses electrical jacks (figure 2, structures connecting to 134) for communication. Narayanaswaim discloses that it is known to equip an integrated jack to transmit the electronic device's data out (figure 2, transmit data to structure 136).

Referring to claim 28: Narayanaswaim discloses a modem (column 2, lines 8-11).

Referring to claims 29-30: Narayanaswaim discloses electrical jacks (figure 2, structures connecting to 150).

### ***Response to Arguments***

9. Applicant's arguments with respect to the claim rejections on the term "upgrade" from the previous Office Action (12/8/04) are persuasive; Examiner withdraws this rejections.



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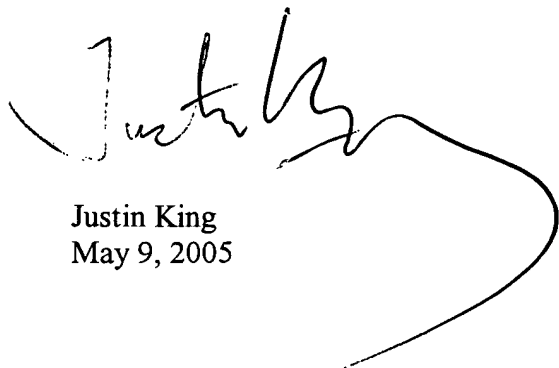
10. Applicant's arguments along the amendments with respect to claims 15-30, 32-35, and 37-39 (Remark, pages 9-12) have been considered but are moot in view of the new ground(s) of rejection as stated above.

***Conclusion***


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin I. King whose telephone number is 571-272-3628. The examiner can normally be reached on max flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark H. Rinehart can be reached on 571-272-3632. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Justin King  
May 9, 2005



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